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10/566,836

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Tatsuya Shimoji

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EXAMINER

JOHNS, CHRISTOPHER C

ART UNIT

PAPER NUMBER

3621

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/566,836

Applicant(s)

SHIMOJI ET AL.

Examiner

Christopher C. Johns

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 5, 6, 14 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5, 6, 14 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 2/2/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. Claims 3, 4 and 7-13 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in the reply filed on 21 May 2008.
2. Claims 1-15 are pending.

Claim Objections

3. Claims 1, 2, 5, 6, 14, and 15 objected to for usage of the functional language “operable to”. It is believed that Applicants intend “operable to” to mean “programmed to” since “operable to” is functional language and therefore given less patentable weight. In light of the notice function of the claims, the Examiner respectfully requests changing “operable to” to “programmed to” where a positive recitation is desired.

Claim Rejections - 35 USC § 112 2nd ¶

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 1, 2, 5, 6, 14, and 15 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. The independent claims 1 and 5 contain reference to “reference destination information of the upper-level resource and a predetermined usage rule, for identifying a view license...”. A

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person having ordinary skill in the art would not understand whether the reference destination information would be able to refer to an “upper-level resource...for identifying a view license”, or whether only the predetermined usage rule is able to identify the view license.

7. Furthermore, the independent claims 1, 6, 14, and 15 contain the limitation of “setting...view licenses”. A person having ordinary skill in the art is not sure what “setting view licenses” should be taken to mean, as the sentence seems to indicate that a secondary clause should be present (e.g. “setting view licenses to (something)”).

8. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

9. Claim 2 is rejected as being at least dependent upon claim 1.

Claim Rejections - 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claim 14 is rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. A computer program *per se* is not statutory subject matter – see MPEP 2106.01.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 1, 2, 5, 6, 14, and 15 are rejected under 35 U.S.C. §102(e) as being anticipated by United States Patent Application Publication 2004/0143760 (“Alkove”).

14. As claims 1, 2, 5, 6, 14, and 15 are best understood by the Examiner, Alkove teaches:

- a. content storage section (it is inherent in the art of computing to have content storage sections) operable to store content which contains an upper-level resource to be first referred to within the content (figure 2, reference numbers 202-1 – 202-N, 202), lower-level resource that can be referred to from the upper-level resource (figure 2, reference numbers 201-4 – 204-N, 204), a startup document (figure 2, reference number 114) providing at least a plurality of pieces of license information (figure 4, reference number 408);
- b. pieces of license information corresponding to either one of reference destination information of the upper-level resource and a predetermined usage rule, for identifying a view license required for viewing all or a part of the resources contained in the content (figure 4, reference numbers 408-414; ¶0026 – “STREAM_ID – specifies the particular data stream(s) that are to be licensed/decrypted...”);
- c. information for referring to a startup document of other content is described in link information for accessing resources of other content (figure 2, reference numbers 202, 202-1 – 202-N. Note how the data in the DRM header 202 corresponds 1-to-1 with the data objects in 204);

- d. communication processing section operable to receive a presentation request for a resource from the receiving terminal (figure 3, reference numbers 377-380, 382);
- e. when the requested resource is not the startup document, presenting the resource to the receiving terminal, and when the requested resource is the startup document, to present the upper-level resource to the receiving terminal and the provide the receiving terminal with the plurality of pieces of license information based on a description of the startup document (in the system, if a user tries to select a portion of the file, that resource will be presented to the user – see ¶0021, further, it is inherent in the art of computing that if a user requests a specific piece of a resource, that specific resource is delivered to the user);
- f. receiving terminal comprising a communication processing section operable to receive the plurality of pieces of license information provided from the server (figure 1, arrows between reference numbers 108 and 110);
- g. view processing section operable, each time a plurality of pieces of license information are provided, to set a plurality of view licenses identified by the plurality of pieces of license information (figure 1, reference numbers 110, 118);
- h. execute view processing on a resource provided from the server by using the set plurality of view licenses (figure 3, reference numbers, 372, 374);
- i. plurality of view licenses are previously stored in the server (figure 1, reference numbers 108, 110) and the receiving terminal obtains from the server the plurality of view licenses set for view processing (figure 1, reference number 118).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 1, 2, 5, 6, 14, and 15 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication 2002/0049679 (“Russell”) in view of U.S. Patent 5,892,900 (“Ginter”).

17. As claims 1, 2, 5, 6, 14, and 15 are best understood by the Examiner, Russell teaches:

j. content storage section (figure 2, reference number 206) operable to store content which contains an upper-level resource to be first referred to within the content, lower-level resource that can be referred to from the upper-level resource (Russell may not explicitly teach an upper-level resource and a lower-level resource, well-known in the art of computing as well as DRM systems (as generally there will be licensing/copyright/protection information in one portion of a file, and the actual content in another portion of the same file). Ginter teaches dividing a file into at least two portions – the first being one with the “information content” (figure 5, reference number 304), and the second being a “permissions record” (figure 5, reference number 808). Ginter does this to properly segment the protected data from the rules which must be interpreted, in order to understand how to protect the data (see especially column 59, lines 7-15 – “package information elements...into a ‘container’ so the information can’t be accessed except as provided by its ‘rules and controls’...”). The sole difference

between the reference and the instant application is that the reference does not disclose segmenting into an “upper” and “lower” section in place of the approach taken by Russell, which appears to have separate files for storing both parts of the information (content data and license/permission). Since each individual arrangement of data and its function are shown in the prior art (though in different references), the difference between the claimed subject matter and the prior art rests not on an individual element or function, but the combination itself – that is, in the substitution of the layered arrangement in Ginter in Russell. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the layered arrangement in place of the separate structure in Russell, because the simple substitution of one known element for another, producing a predictable result, renders the claim obvious);

k. a startup document (figure 3, reference number 309) providing at least a plurality of pieces of license information (figure 3, reference numbers 318, 320, 328);

l. pieces of license information corresponding to either one of reference destination information of the upper-level resource and a predetermined usage rule, for identifying a view license required for viewing all or a part of the resources contained in the content (figure 3, reference numbers 318, 320, 322, 324, 326, 328);

m. information for referring to a startup document of other content is described in link information for accessing resources of other content (figure 3, reference number 326);

- n. communication processing section operable to receive a presentation request for a resource from the receiving terminal (figure 1, lines between reference numbers 102 and 110, 110 and 106);
- o. when the requested resource is not the startup document, presenting the resource to the receiving terminal, and when the requested resource is the startup document, to present the upper-level resource to the receiving terminal and the provide the receiving terminal with the plurality of pieces of license information based on a description of the startup document (the license data object 309 must be provided to the user requesting the license (reference numbers 303, 305, 307) before the resource is able to be used);
- p. receiving terminal comprising a communication processing section operable to receive the plurality of pieces of license information provided from the server (figure 3, lines between 309, and 303, 305, 307; figure 4, reference number 412);
- q. view processing section operable, each time a plurality of pieces of license information are provided, to set a plurality of view licenses identified by the plurality of pieces of license information (the protected database, figure 4, reference number 416, is modified based on the licenses received – see ¶0055);
- r. execute view processing on a resource provided from the server by using the set plurality of view licenses (figure 4, reference number 424);
- s. plurality of view licenses are previously stored in the server and the receiving terminal obtains from the server the plurality of view licenses set for view processing (figure 2, reference number 214).

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- t. United States Patent 7,260,557 (Chavez et al);
- u. United States Patent 7,222,232 (Venkatesan et al);
- v. United States Patent Application Publication 2003/0217275 (Bentley et al).

19. **Examiner's Note:** Although Examiner has cited particular columns, line numbers and figures in the references as applied to the claims above for the convenience of the applicant(s), the specified citations are merely representative of the teaching of the prior art that are applied to specific limitations within the individual claim and other passages and figures may apply as well. It is respectfully requested that the applicant(s), in preparing the response, fully consider the items of evidence in their entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Christopher C. Johns whose telephone number is (571)270-3462. The Examiner can normally be reached on Monday - Friday, 9 am to 5 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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